

Appl. No. 10/760,343
Amendment dated: September 19, 2005
Reply to OA of: May 19, 2005

REMARKS

Applicants acknowledge with appreciation the indication that claims 9 and 15 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. §112, second paragraph set forth in the outstanding Official Action. Claim 15 has been amended to delete the term "(PCM)." Applicants respectfully assert that claims 9 and 15 are now in full compliance with 35 U.S.C. §112, second paragraph and are clearly patentable over the references of record.

Applicants have also attempted to address the rejection of claims 9 and 15 under 35 U.S.C. §112, first paragraph by amending claim 15 to make it clear that the shock absorbing member is made of materials which are not composites of plastics. This amendment is clearly supported by the specification, e.g., page 4, lines 10-16, as well as the claims as initially filed. Applicants have consistently asserted throughout the prosecution of this application that the term "non plastic composite material" should be understood as "materials that are not composites of plastics." Applicants respectfully assert that claims 9 and 15 are now in full compliance with all the requirements of 35 U.S.C. §112, first paragraph and are clearly patentable over the references of record.

Additionally, Applicants have amended claims 2, 7 and 12 and canceled claims 1, 4, 5, 11, 13 and 14 in order to place the claims in better condition for allowance. Applicants note that nowhere in the Official Action, including each of the rejections of the claims under 35 U.S.C. §103(a), is it indicated that the references of record teach or suggest the limitations of claims 7 and 14.

Applicants wish to direct the Examiner's attention to the basic requirements of a prima facie case of obviousness as set forth in the MPEP § 2143. This section states that to establish a prima facie case of obviousness, three basic criteria first must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the

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reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Section 2143.03 states that all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Claim 7 has been rewritten in independent form to incorporate all of the limitations of claim 1, except for the recitation of a shock absorbing member made of non plastic composite material. Claim 2 has been amended to depend from claim 7. The Official Action has not indicated where in the references each element of the presently amended claim 7 is disclosed or suggested. None of the references of record, either standing alone or combined, disclose a shell for bicycle saddle wherein the shock-absorbing member includes an upper layer of thermoplastic urethane, a bottom layer of thermoplastic urethane and an intermediate layer of fabric sheet sandwiched in between said upper layer and said bottom layer as claimed in claim 7.

Further, because the recitation of a shock-absorbing member made of non plastic composite material has been deleted, Applicants respectfully submit that the §112, first paragraph rejection with respect to claim 7 and all claims depending therefrom has been obviated. Accordingly, Applicants respectfully assert that claim 7 and all claims depending therefrom are now in full compliance with all the requirements of §112 and are clearly patentable over the references of record.

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Additionally, claim 12 has been amended to incorporate the limitations of claims 13 and 14 and to delete the recitation of a shock absorbing member made of non plastic conforming material. The Official Action has not indicated where in the references of record each element of amended claim 12 is disclosed or suggested.

The Official Action states, with respect to claim 11, that Bigolin in view of Barton disclose shock-absorbing member made of a thermoplastic urethane film adhered to a top surface of said body. However, the Official Action has not applied these references to claim 14, which is now incorporated into claim 12. Applicants assert that Bigolin in view of Barton do not disclose the limitations found in presently amended claim 12. Specifically, the Official Action urges that Bigolin discloses a shock absorbing member (9) that fills up the opening (11) in body (2). However, a careful reading of the Bigolin reference reveals that no such shock-absorbing member is disclosed.

First, as disclosed in the abstract and detailed description of the drawings, body (2) of Bigolin comprises first layers (8) and second layers (9). Thus, as an initial matter, it is clear that the body (2) is made of both layers (8) and (9) and that second layer (9) is not a separate shock-absorbing member that is placed on top of and within the body. Therefore, because second layer (9) cannot be construed as a separate shock-absorbing member as claimed in the present invention, Bigolin fails to disclose or suggest each and every element of the present invention. Also, the seat bottom in Barton clearly fails to remedy this deficiency.

Additionally, the present invention recites that the shock-absorbing member fills up the opening in the body. Bigolin discloses an opening (11) in the body (2) of the saddle, but does not disclose a shock absorbing member that fills up this opening. Rather, second layer (9) serves to form the bottom of the opening (11), as can be seen in Figure 2 and 3. To the contrary, the shock-absorbing member of the presently claimed invention is placed in and fills the entire opening in the body. Therefore Bigolin fails to disclose this element of the presently amended claims. Again, it is clear that

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Barton does not remedy this deficiency. Because the references of record, either standing alone or in combination, fail to disclose each and every element of the presently amended claims, Applicants respectfully request that the §103(a) rejection be withdrawn.

Finally, because the recitation of a shock-absorbing member made of non plastic composite material has been deleted, Applicants respectfully submit that the §112, first paragraph rejection of claim 12 has been obviated.

In view of the above comments and further amendments to the claims and drawings, favorable reconsideration and allowance of all of the claims now present in the application are most respectfully requested.

Respectfully submitted,

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